

**REMARKS**

**STATUS OF CLAIMS:**

After entry of the foregoing amendments, claims 1-16 are all of the claims currently pending in this application. Claims 1-5 and 8-10 are rejected. The Examiner objects to claims 6 and 7. New claims 11-16 are added via this Amendment.

**35 U.S.C. §112:**

Claim 8 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite because the recitation of “the hood” in line 1 is allegedly not provided with sufficient antecedent basis. Accordingly, claim 8 is amended to depend from claim 2 so as to provide proper antecedent support for “the hood.” Accordingly, withdrawal of the rejection under 35 U.S.C. §112, second paragraph, is respectfully requested.

**35 U.S.C. §102:**

Claims 1, 3 and 9 are rejected under 35 U.S.C. §102(b) as being anticipated by Schneider (U.S. Patent No. 2,109,932). Claims 1 and 3 are also rejected under 35 U.S.C. §102(b) as being anticipated by Bollenbacher (U.S. Patent No. 4,286,846). Applicant respectfully traverses these rejections in view of the following remarks.

The Examiner cites both Schneider and Bollenbacher for an alleged disclosure of a human eye that includes a lens and a retina. Claim 1 is amended to recite a “camera” lens. The human eye does not include a camera lens. Accordingly, Applicant respectfully submits that Schneider and Bollenbacher fail to disclose each feature recited in claim 1, and requests that the rejection of claims 1, 3 and 9 under 35 U.S.C. §102(b) be withdrawn.

**35 U.S.C. §103:**

*Claim 5*

Claim 5 is rejected under 35 U.S.C. §103(a) as being unpatentable over Schneider or Bollenbacher in view of David<sup>1</sup> (U.S. Patent No. 1,808,208). Applicant respectfully traverses this rejection in view of the following remarks.

David is relied upon for an alleged disclosure of a transparent member attached to a windowpane by an adhesive. Applicant respectfully submits that David fails to make up for the deficient teachings of the art with respect to claim 1, and the combination of Schneider or Bollenbacher in view of David would have failed to teach or

---

<sup>1</sup> Applicant presumes that the Examiner intended to cite “David,” not “Davis” in the rejection statement.

suggest each feature recited in claim 5 at least due to its dependency on claim 1. Accordingly, withdrawal of the rejection of claim 5 under 35 U.S.C. §103(a) is respectfully requested.

*Claims 1-4, 9 and 10*

Claims 1-4, 9 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Applicant's admitted prior art (hereinafter "AAPA") in view of Schneider or Bollenbacher. Applicant respectfully traverses this rejection in view of the following remarks.

The Examiner cites the AAPA for an alleged disclosure of a car sensor comprising a lens 1 that is provided on an inner side of a windowpane 3 to condense light coming from an object outside the window. The Examiner asserts that a main body of the camera also includes a sensor that detects an object by means of light that is passed through the lens.

Both Schneider and Bollenbacher are relied upon for the alleged disclosure of a transparent member that is provided between a windowpane and the lens so as to direct light toward the eye of a driver. The Examiner concludes that it would have

been obvious to combine the teachings of the applied references so as to “enhance the accuracy in receipt of the incoming light.”

**I. DESIRABILITY OF THE COMBINATION IS NOT SUGGESTED**

Applicant respectfully submits that the mere fact that references can be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 (Fed. Cir. 1990); (see also MPEP §2144.01). Neither of the applied references suggests the desirability of the combination set forth by the Examiner. In particular, the AAPA is designed to receive rays of light passing through a windowpane at a fixed distance proximate the windowpane. One skilled in the art at the time of the AAPA would have had enough knowledge to properly configure the system of the AAPA so as to obtain an accurate receipt of incoming light at the predetermined distance. Nothing in the AAPA would have suggested that the accuracy of the incoming light needed to be enhanced. Thus, the required suggestion to combine the references is not found in the AAPA.

Schneider and Bollenbacher also would have failed to provide the required suggestion of desirability to make the combination. In particular, both of these references are directed to allowing a driver of a vehicle to view an overhead light, such as a traffic light. This is accomplished by utilizing a device that reflects overhead images from the traffic light toward a driver. There is no disclosure in Schneider or Bollenbacher that would have led one to believe that the devices disclosed in these references, for bending overhead light toward a driver, would have enhanced the accuracy of the incoming light.

Moreover, as one skilled in the art would have understood from Schneider and Bollenbacher, the lens devices of these references are designed such that a person sitting at a distance of a front seat could view a presumably focused image. In contradistinction, the AAPA discloses a device that is under a sloping portion of a windowpane and is closer to the windowpane than the front seat. These differences further demonstrate the lack of desirability to combine the references due to their optically different requirements.

Accordingly, one skilled in the art would not have been taught or suggested that the device for bending light rays from an overhead image, as in either Schneider or Bollenbacher, would have been of any benefit to the device disclosed in the AAPA. Thus, the applied prior art does not suggest the desirability of the combination alleged by the Examiner, and does not support the rejection.

## **II. THE PROPOSED MODIFICATION WOULD CHANGE THE PRINCIPLE OPERATION OF THE AAPA**

Applicant respectfully submits that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810 (CCPA 1959); (see also MPEP §2144.01). The applied references are not sufficient to render the claims obvious because the proposed combination would change the principle of operation of the invention being modified. In particular, the device of Schneider and Bollenbacher is used so as to observe an overhead feature such as the traffic light. The light coming from the feature is bent toward the driver so that the traffic light can be seen without the driver having to extend his neck forward and look up at the light.

On the other hand, the AAPA is directed to utilizing light that comes from an object in front of the vehicle, but not necessarily above the vehicle. Thus, if the teachings of either Schneider or Bollenbacher were applied to the AAPA, then the AAPA would have its principle of operation changed because it would no longer be able to view images directly in front of the car. So for this additional reason, the combination of the references does not render the present claims obvious because the principle of operation would be changed.<sup>2</sup> Accordingly, the rejection of the claims under 35 U.S.C. §103(a) should be withdrawn.

*Claim 5 (second rejection)*

Claim 5 is rejected under 35 U.S.C. §103(a) as being unpatentable over the AAPA in view of Schneider or Bollenbacher, and further in view of David. Applicant respectfully traverses this rejection in view of the following remarks.

The Examiner relies on David for the alleged disclosure of a transparent member attached to a windowpane using an adhesive. The use of such adhesive does not make up for the deficient teachings of Schneider, Bollenbacher or the AAPA.

---

<sup>2</sup> The AAPA would also be rendered unsatisfactory for its intended purpose, which evidences the lack of motivation to combine the references. (See MPEP §2143.01.)

Thus, Applicant respectfully submits that claim 5 is patentable over the applied references at least by virtue of its dependency on claim 1.

**NEW CLAIMS:**

Applicant hereby adds new claims 11-16 to obtain more varied protection for the invention. New claims 11-13 respectively capture the allowable subject matter of claims 6-8, as noted on page 6 of the Office Action. New claims 14-16 further define aspects of the invention, which Applicant submits are also not taught or suggested by the applied references.

In view of the preceding amendments and remarks, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue that the Examiner feels may be best resolved through a personal or telephonic interview, he is kindly requested to contact the undersigned attorney at the local telephone number listed below.

AMENDMENT UNDER 37 C.F.R. §1.111  
U.S. Serial No. 10/002,200

Art Unit 2878  
Q66887

The USPTO is directed and authorized to charge all required fees (except the Issue Fee and/or the Publication Fee) to our Deposit Account No. 19-4880. Please also credit any overpayment to said Deposit Account.

Respectfully submitted,

  
\_\_\_\_\_  
Daniel V. Williams  
Registration No. 45,221

**SUGHRUE MION, PLLC**  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: January 26, 2004